

# Office Action Summary

Application No.

09/811,427

Applicant(s)

CONTRUCCI ET AL.

Examiner

Scott Kastler

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1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-10,16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-10,16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Double Patenting***

Applicant is advised that should claims 1 and 3-5 be found allowable, claims 16 and 18-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The above claims differ only in the intended use of the claimed apparatus (self reducing materials or melting/refining pre-reduced materials). As stated above, it has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. *See In re Casey*, 152 USPQ 235.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-10, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of the instant disclosure. The admitted prior art of the instant disclosure, as described at pages 2 and 3 of the specification for example, teaches a furnace showing all aspects of the above claims except the use of a plurality of reduction

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chambers (the admitted prior art of the instant disclosure teaches the use of a single reduction chamber). However, the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because it has been well settled that motivation to multiply the numbers of a component shown by the applied prior art to be employed singularly, in order to multiply the effect of the component, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made. See *In re Harza*, 274 F.2d 669, 124 USPQ 378, and MPEP 2144.05 VI. B. In the instant case, in order to increase the amount of material which may be reduced at one time, motivation to increase the number of reduction chambers in the furnace described in the admitted prior art of the instant disclosure, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments filed on 8-28-2002 have been fully considered but they are not persuasive. Applicant's argument that in the instant case, the multiplication of parts (the reduction cells) of the instant claims produces a new and unexpected result (improved adjustability of the furnace capacities) and is therefore unobvious over the admitted prior art of the instant disclosure is not persuasive. Applicants have not as yet provided and evidenced in proper declaration or affidavit form to support the assertions of new and unexpected results. It has been well settled that arguments or conclusory statements in the specification, unsupported by any factual showing, are insufficient to establish new or unexpected results. See *In re Wood et al*, 199 USPQ 137, and MPEP 2145.

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*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (703) 308-2506. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-3050. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Scott Kastler  
Primary Examiner  
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sk  
May 15, 2003

### *Claim Objections*

Claims 2, 7, 12 and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The above claims do not fairly further limit the independent claims from which they depend because the above apparatus claims recite only limitations dealing with the suggested method of use of the claimed apparatus (the melting and refining conditions). It has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. *See In re Casey*, 152 USPQ 235.

### *Double Patenting*

Applicant is advised that should claims 1-5 be found allowable, claims 11-15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The above claims differ only in the intended use of the claimed apparatus (self reducing materials or melting/refining pre-reduced materials). As stated above, it has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. *See In re Casey*, 152 USPQ 235.

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Applicant is advised that should claims 6-10 be found allowable, claims 16-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The above claims differ only in the intended use of the claimed apparatus (self reducing materials or melting/refining pre-reduced materials). As stated above, it has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. *See In re Casey*, 152 USPQ 235.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Seelig et al, Anderson, Nagata et al, and Takao et al. Each of Seelig et al, Anderson, Nagata et al, and Takao et al teach the use of a plurality of connected reducing furnaces (they are connected through the gas pipes etc.) which fairly show all aspects of the above claims since the claims as written, do not require that the modular furnace include separate reduction chambers attached to a common lower shaft (8), which is not shown by the above references.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of the instant disclosure. The admitted prior art of the instant disclosure, as described at pages 2 and 3 of the specification for example, teaches a furnace showing all aspects of the above claims except the use of a plurality of reduction chambers (the admitted prior art of the instant disclosure teaches the use of a single reduction chamber). However, the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because it has been well settled that motivation to multiply the numbers of a component shown by the applied prior art to be employed singularly, in order to multiply the effect of the component, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made. See *In re Harza*, 274 F.2d 669, 124 USPQ 378, and MPEP 2144.05 VI. B. In the instant case, in order to increase the amount of material which may be reduced at one time, motivation to increase the number of reduction chambers in the furnace described in the admitted prior art of the instant disclosure, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

***Conclusion***



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